

REMARKS

Claims 1-16 and 18-30 were presented for examination and were pending in this application. In a Final Office Action dated November 12, 2004, claims 1-16 and 17-30 were rejected. Applicants thank the Examiner for examination of the claims pending in this application and address the Examiner's comments below.

Applicants propose amending claim 30 to correct the antecedent basis issue identified by the Examiner.

Response to Rejection Under 35 USC § 112, Paragraph 1

In the 5th paragraph of the Office Action, the Examiner has rejected claims 1-16 and 18-30 as failing to comply with the written description requirement. The Examiner's rejection hinges on applicants' use of the term "not prescreened" and "any seller." The Examiner points to the specification, which states that users must register before they can post or bid (in the described embodiment of the invention) and argues that such registration is akin to prescreening. Applicants strongly disagree. As will be explained below, a registration process does not discriminate among any sellers coming into the marketplace and is not the same as "preselecting" sellers. Thus, sellers in Applicants invention are not prescreened.

As is well-known, applicants can be their own lexicographer. In their previous response, applicants attempted to use the term "prescreened" to show the concept of having a website "approve" sellers' qualifications before the sellers can bid on requests for services or post offers for sellers' services. The previously cited art describes a system in which the site "prescreens" users by allowing only "experts" vetted in advance to bid or answer certain types of questions. In contrast, applicants' invention allows any seller of the system to bid on a request or to post his or her services. Applicants' invention does not "vet" a seller's qualifications before allowing the

seller to register, bid or post. If a seller thinks he can handle a request, he may post. The registration process described in applicants' specification does not "vet" sellers' qualifications, but merely takes their name and address, self-descriptions, etc. Any seller is allowed to register in a non-discriminatory manner. The registration process disclosed in applicants' specification is non-discriminatory and is not the same as prescreening. Therefore, a system that does not prescreen sellers is disclosed in applicants' specification.

Applicants' specification clearly supports a system in which any seller can list his services as a seller. No vetting is performed. Thus, the system is "open" and applicants therefore used the shorthand term "open" in their previous response (see also, applicants' specification at page 3, lines 4-15). Applicants amended each independent claim to clearly recite that users are not prescreened before they can bid or post and that "any seller" can bid or post services (Some claims recite bidding; some recite posting). This is what applicants mean when they use the shorthand term "open."

Applicants expressly state herein that the term "prescreened" is not the same as mere registration on the site and applicants expressly disclaim such a meaning. Instead, prescreening means that the site takes a more active role in determining who can bid or post for a particular task.

Applicants' definition of the term "prescreening" is supported by the operation of their system described in the specification. As the Examiner points out, the described example of applicants' invention does indeed require potential users to register. The registration process is non-discriminatory and anyone can register. At that time, the user inputs a short description of himself and/or his services (see Fig. 5c). Furthermore, as is clear from the description in the specification, once a person has registered and has become a user, the site puts no limitations on

which user can bid for which project. Similarly, no limitations are put on what services the user can advertise for sale. Applicants' specification in no way suggests that only certain users can bid on a particular task or post their services for a particular task. This is directly contrary to Walker '223, which discusses "experts" that must be prescreened and their credentials approved before they can bid on a task.

MPEP § 2163(I)(B) states: "While there is no *in haec verba* requirement, newly added claim limitations must be supported in the specification through express, implicit, or inherent disclosure." Here, the specification provides adequate disclosure to support a claim limitation that sellers are not prescreened and that any seller can bid (or post).

MPEP § 2163(III)(B) provides a methodology for analyzing whether the written description requirement has been met. The steps include:

1. (A) Identify the claim limitation at issue; and

-
- (B) Establish a *prima facie* case by providing reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed. A general allegation of "unpredictability in the art" is not a sufficient reason to support a rejection for lack of adequate written description.

When appropriate, suggest amendments to the claims which can be supported by the application's written description, being mindful of the prohibition against the addition of new matter in the claims or description. See *Rasmussen*, 650 F.2d at 1214, 211 USPQ at 326.

-
-
- 2) Upon reply by applicant, before repeating any rejection under 35 U.S.C. 112, para. 1, for lack of written description, review the basis for the rejection in view of the record as a whole, including amendments, arguments, and any evidence submitted by applicant. If the whole record

now demonstrates that the written description requirement is satisfied, do not repeat the rejection in the next Office action. If the record still does not demonstrate that the written description is adequate to support the claim(s), repeat the rejection under 35 U.S.C. 112, para. 1, fully respond to applicant's rebuttal arguments, and properly treat any further showings submitted by applicant in the reply. When a rejection is maintained, any affidavits relevant to the 112, para. 1, written description requirement, must be thoroughly analyzed and discussed in the next Office action. See *In re Alton*, 76 F.3d 1168, 1176, 37 USPQ2d 1578, 1584 (Fed. Cir. 1996).

The following paragraphs describe in detail some portions of applicants' specification that would have lead a person skilled in the art at the time the application was filed to have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed. For example, Applicants' Fig. 5c shows a registration process that is clearly open to all persons. Once a person is registered, he or she is a user of the system and can bid on any posted job or post his or her services. In some implementations, the posting user can look at a bidder's feedback and decide whether they want to employ the bidder. But this is different from "prescreening" the potential bidders before they bid or post, so that only "prescreened" experts can bid or answer posted questions (as in Walker '223). In applicants' system, any seller is free to represent himself or herself as an expert if he or she so desires.

Applicants have employed the term "prescreened" in an attempt to differentiate between their invention and Walker '223. Applicants' specification clearly shows an example of a system in which "any seller" can post services or bid on a request for services. Thus, Applicants' use of the terms "any seller" and "not prescreened" to describe their invention is a reasonable and clearly descriptive way of amending applicants' claims to distinguish over the cited art. **The**

Examiner is invited to contact the undersigned if the Examiner has preferred claim language, per the MPEP section 2163.

The Examiner states on page 3, lines 14-15 that the claim limitations concerning lack of prescreening were not considered. Applicants believe that these limitations should have been considered in light of the above remarks. The limitations involving lack of “prescreening” and bids by “any seller” are a legitimate attempt to patentably distinguish applicants’ claimed invention over Walker. Applicants can be their own lexicographer and applicants’ intended meaning is clear, both from their previous remarks and the clarifying remarks presented above. Because Applicants have clearly presented arguments defining and supporting these limitations, the Examiner is respectfully requested to consider them.¹

In light of the above arguments, applicants respectfully request that the rejections under § 112, first paragraph, be reconsidered and withdrawn.

Response to Rejection Under 35 USC § 112, Paragraph 2

In the 7th paragraph of the Office Action, the Examiner has rejected claim 30 as not specifically pointing out and distinctly claiming the subject matter that Applicants regard as the invention. Applicants propose amending claim 30 to change “the” to “a” in claim 30. Applicants respectfully request that the Examiner enter this minor claim amendment because it corrects a minor antecedent basis issue pointed out by the Examiner.

Response to Rejection Under 35 USC 103(a)

In the 10th paragraph of the Office Action, the Examiner rejects claims 1-5, 9, 16, 18-21, and 25-29 under 35 USC § 103(a) as allegedly being unpatentable over Walker et al., U.S. Patent

5,862,223 (“Walker ‘223”) in view of Salas et al, U.S. Patent 6,233,600 (“Salas”); in the 11th paragraph of the Office Action, the Examiner rejects claims 6-8 in further view of Rackson et al., U.S. Patent 6,415,270 (Rackson); in the 12th paragraph of the Office Action, the Examiner rejects claims 10-11 in further view of Glasser et al., U.S. Patent 5,956,715 (Glasser). In the 13th paragraph of the Office Action, the Examiner rejects claims 12-15 as being unpatentable over Walker in further view of Bi et al., U.S. Patent 6,311,178 (Bi); in the 14th paragraph of the Office Action claims 22-23 as being unpatentable over Walker ‘223 in further view of Bi, and in further view of Walker et al. 6,484,153 (Walker ‘153). In the 15th paragraph of the Office Action, the Examiner rejects claim 24 as being unpatentable over Walker ‘223 in further view of Salas and in further view of Murcho, Jr., U.S. Patent 6,578,014 (Murcho, Jr.). In the 16th paragraph of the Office Action, the Examiner rejects claim 30 as being unpatentable over Walker ‘223 in further view of Bi and in further view of Salas. These rejections are respectfully traversed.

Independent Claims 1, 12, 16, 18-21 and their Dependent Claims

The following argument applies to each of independent claims 1, 12, 16, and 18-21 and their dependent claims. The dependent claims are patentable at least for the reasons discussed below in connection with their parent claims.

The Examiner contends that Walker ‘223 discloses that “any seller” can bid, citing col. 13, lines 13-20, 35-39, and col. 14, lines 25-32 of Walker ‘223. Applicants disagree with the Examiner’s interpretation of Walker ‘223 and with the Examiner’s contention that the “experts” of Walker ‘223 are the same as the non-prescreened “any sellers” of applicants’ claimed

¹ Applicants note that, even though the Examiner states that she did not consider the “prescreening” limitations, she addressed this limitation in the rejection. Applicants explain below why the Examiner’s reading of Walker ‘223 is incorrect.

invention. The first portions of Walker '223 cited by the Examiner (col. 13-20 and 35-39) disclose physical details of the hardware system and only mention people posting "data inquiries" (i.e., buyers, not sellers). Applicants believe these sections to be irrelevant to the Examiner's argument. The second portions of Walker '223 cited by the Examiner (col. 14, lines 25-32) merely state the existence of "experts" in the system. The Examiner fails to consider the more pertinent parts of Walker '223, which define what an expert is and how they are prescreened. Walker further specifies that only "experts" can bid. Furthermore, Walker '223 explicitly states that only experts are invited to bid. See for example, col. 7, lines 30-61, which makes it clear that only previously identified (i.e., "prescreened") experts ever learn of a user's request for bids and only those prescreened experts are allowed to submit a bid. That portion of Walker '223 states:

Once the job request has been sent, the end user waits to receive any bids by the bid deadline specified. As soon as the central controller at the Exchange receives the complete job request, **it first searches its proprietary database of Russian history experts.** Then, if additional experts are likely to be needed, it activates a search program designed to access and interrogate outside databases of known experts who might be qualified to handle the job request. This outside database search could be done using conventional paper-based directories (such as the American Medical Association's American Medical Directory which lists the doctor's educational background and any board-certified specialty), or with electronic directories available online (such as the Martindale-Hubbell Law Directory which contains entries for lawyers and law firms in the United States as well as over 140 foreign countries). In the example above, college course catalogs can be searched for an authority on late 18th century Russia, with special knowledge of Catherine the Great. **Once one or more suitable experts are identified, the Exchange sends a**

message to the expert (e-mail, fax, beeper, phone, etc.) briefly describing the job request and asking the expert if he might be willing to consider bidding on the assignment by 5:00 PM, Friday, Jul. 12, 1996. The name of the client is not revealed. If the expert answers that he might be interested, and the user has placed no pre-qualification restrictions on who can see the job request, **the full text of the job request without the user's name or address is forwarded to the expert with a request that he respond with a bid by the bid deadline.** Alternatively, the user is notified of each expert's interest and is offered the opportunity to review the expert's qualifications prior to the Exchange sending out the full job request.

(emphasis added).

This section of Walker '223 makes it very clear that Walker does not allow "any seller" to respond to bids, as recited in certain ones of the pending claims. In Walker '223, only prescreened, pre-identified "experts" are allowed to respond to requests for bids (or to post). Applicants' invention patentably differs from Walker '223 in at least this very important distinction. The rejections of independent claims 1, 12, 16, 18-21, and their dependent claims patentably distinguish over Walker '223 for at least this reason. This argument is related to the argument made above concerning the rejection under § 112, which is incorporated by reference into this section of the response.

The other references cited by the Examiner (Salas, Rackson, Glasser, Bi, Walker '153, and Murcho, Jr.) completely fail to remedy the above-discussed deficiencies of Walker '223. The pending claims patentably distinguish over the various cited combinations of Walker '223 and other documents. The pending claims should be allowed for at least this reason.

Conclusion

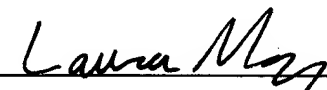
Applicants respectfully submit that claims 1-16 and 18-30, as presented herein, are patentably distinguishable over the cited reference (including references cited, but not applied). Therefore, Applicants request reconsideration and allowance of these claims.

In addition, if the Examiner wishes to suggest specific claim amendments that would place this application in condition for allowance, she is invited to contact the undersigned.

RESPECTFULLY SUBMITTED,
BEERUD D. SHETH AND SRINIVAS
ANUMOLU

Date: February 14, 2005

By: _____


Laura A. Majerus, Reg. No. 33,417
FENWICK & WEST LLP
Silicon Valley Center
801 California Street
Mountain View, CA 94041
Phone: (650) 335-7152
Fax: (650) 938-5200